

## **REMARKS**

The Examiner's Final Office Action of May 9, 2003 has been received and carefully considered. Prior to this Office Action, claims 1-22 were pending in the application, of which claims 1 and 20 are independent. Claims 1-3, 5-7, 9-10, and 14-22 are herein amended. Accordingly, claims 1-22 remain pending in the application. Applicant thanks the Examiner for discussing the allowability of the claims as herein amended in our telephonic interview of August 5, 2003. For the reasons discussed herein, it is respectfully submitted that claims 1-22 are allowable.

### **I. Overview of Claim Amendments**

Initially, Applicant thanks the Examiner for conducting a telephonic interview to discuss the amendments set forth herein. In accordance with the Examiner's suggestion made during our telephonic interview, Applicant has amended claims 1-3, 5-7, 9-10, and 14-22 to (1) remove the "associated with" phrases set forth in the claims prior to this amendment to positively claim the feature of associating an advertisement with a communication at a sending party's data processing system; and (2) remove "user-managed" phrases, also set forth in the claims prior to this amendment. Where appropriate, the claims are further amended to recite the feature that using the method of the invention, one or more advertisements can be associated with the communication. Support for this feature is found in the specification on at least page 6, lines 7-11.

### **II. Rejection Under 35 U.S.C. 103**

Claims 1-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/24213 A1 to Goldschmitt et al. (hereinafter Goldschmitt) in view of "World Wide Watch" (hereinafter The Mail) and U.S. Patent No. 6,047,310 to Kamakura et al (hereinafter Kamakura). Goldschmitt discloses a method for providing free e-mail messaging to end-users, wherein the free e-mail messaging is supported by sponsors who advertise their products and services by appending an advertisement to an e-mail

message. The e-mail sent by a sender is received and stored at a remote mail server associated with advertisement sponsors. For example, referring to Figure 1 of Goldschmitt, end-users 12, 14 and 16 are connected via communication links 17 (i.e. telephone lines, satellite links, fiber optic cabling and other existing telecommunication infrastructure), to a central e-mail messaging center 18. The users 12, 14, and 16 can be subscribers on an on-line service (e.g., Compuserve™) that is managed and controlled at the center 18. Alternatively, each end user 12, 14, and 16 can have internet addresses; and a center 18 is providing on-line services to a member 20, who is also an end-user for mail messaging purposes. The messages are routed to the center 18 and stored in e-mail buffer 22 until accessed by the user receiving the e-mail. Once the receiving user accesses her mail, an advertisement is appended to the message stored in the buffer 22 and transmitted to the user along the appropriate transmission line 17. (See Goldschmitt, page 8, lines 4-13).

Applicant respectfully submits that Goldschmitt does not disclose a method of transmitting an advertisement from a sending party to a receiving party wherein, *inter alia*, the associating of at least one pre-selected advertisement with a communication takes place within the data processing system of the sending party, as set forth in amended claim 1. Rather, in accordance with the method of Goldschmitt, the step of appending an advertisement to the message occurs not within the data processing system of the sending party, but at a remote e-mail messaging center 18.

As for Kamakura, Applicant submits that this reference is directed to an information providing apparatus for automatically determining the distribution of information received by a receiver from a sender. In particular, Kamakura discloses associating (i.e. bringing together) a recipient that has requested to receive information (i.e. advertisement) of a certain type with a sender (e.g., commodities merchant) that desires to find recipients that want and are willing to receive its information. Specifically, Kamakura discloses a system having a receiver terminal 13, a distribution terminal 11, and a sender terminal 14. (See Figures 2 and 3). When the

process of Kamakura is started, the sender terminal 14 registers the sender profile 32 generated by the sender and the transmission advertisement document 26 to the distribution host computer 11. (See Column 7, lines 13-19). Thereafter, the distribution list generating portion 23 of the distribution host computer 11 determines distributees of the advertisement information corresponding to the advertisement reception requirement 22 and the advertisement transmission requirement and generates the distribution list 25. (See Column 7, lines 41-46). As with Goldschmitt, the association of the advertisement with the communication in accordance with the method of Kamakura clearly takes place within the distribution host computer 11, not within the data processing system of the sending terminal 14.

Therefore, it is respectfully submitted that Kamakura also does not disclose or suggest a method of transmitting an advertisement from a sending party to a receiving party wherein, *inter alia*, the associating of at least one pre-selected advertisement with a communication is accomplished within the data processing system of the sending party.

Moreover, as the Examiner has suggested, The Mail also fails to disclose a method of transmitting an advertisement from a sending party to a receiving party wherein, *inter alia*, the associating of at least one pre-selected advertisement with a communication is accomplished within a data processing system of the sending party. Accordingly, inasmuch as the combination of Goldschmitt, Kamakura, and the Mail, fail to disclose or inherently suggest each and every element of claim 1, it is respectfully requested that a *prima facie* case of obviousness has not been presented. Accordingly, reconsideration and withdrawal of the rejection of claim 1, under § 103(a), is respectfully requested.

Claims 2-19 are dependent on claim 1. Accordingly, since these claims inherently incorporate each and every element of claim 1, the foregoing argument with respect to claim 1 are also applicable to claims 2-19. Accordingly, the

reconsideration and withdrawal of the rejection of these claims, under § 103(a), is also kindly requested.

Claims 20 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt in view of Kamakura and Uomini. Claim 20, as herein amended, is directed to a method of transmitting an electronic communication including at least one advertisement from a data processing system of a sending party to a data processing system of a receiving party comprising, *inter alia*, the step of locating a data file containing signature information on the data processing system of the sending party, said signature information being appended to electronic communications originating from the sender's data processing system.

It is apparent from the discussion above with respect to the rejection of claims 1-19 that neither Goldschmitt, Kamakura, or the Mail disclose associating at least one pre-selected advertisement with a communication within the data processing system of the sending party. Accordingly, it is submitted that it would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include transmitting the electronic communication including said advertisement using the data processing system of the sending party.

Inasmuch as Uomini also does not disclose or suggest a method of transmitting an electronic communication including an advertisement from a data processing system of a sending party to a data processing system of a receiving party, the combined teachings of Goldschmitt, Kamakura, and Uomini do not present a *prima facie* case of obviousness under 35 U.S.C. 103. Accordingly, the reconsideration and withdrawal of the rejection of claim 20, under § 103(a), is respectfully requested.

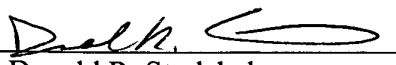
Claim 21 is dependent on independent claim 20. Accordingly, since this claim inherently incorporate each and every element of claim 20, the foregoing argument with respect to claim 20 is also applicable to claim 21. Accordingly, the reconsideration and withdrawal of the rejection of claim 21, under § 103(a), is also requested.

Claim 22 stands rejected under 35 U.S.C. 103(a), as being unpatentable over Goldschmitt, The Mail and Kamakura, as applied to claim 1, and further in view of Uomini, U.S. Pat. No. 6,018,761. Inasmuch as claim 22 is dependent on claim 1, and is considered to include each and every limitation thereof, the arguments set forth above in respect to the rejection of claim 1 are also applicable to claim 22. In particular, it is submitted that since neither Goldschmitt, The Mail, or Kamakura disclose a method of transmitting an advertisement from a sending party to a receiving party wherein, *inter alia*, the associating of at least one pre-selected advertisement with a communication is accomplished within a data processing system of the sending party, a *prima facie* case of obvious has not be established under 35 U.S.C. 103(a). Accordingly, the Examiner's reconsideration and withdrawal of the rejection of claim 22, under § 103(a), is respectfully requested.

## II. Conclusion

Having responded to each and every rejection set forth in the outstanding Final Office Action, it is submitted that claims 1-22 are now in condition for allowance. An early and favorable Notice of Allowance is courteously solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate the allowance of one or more of the pending claims, the Examiner is invited to contact Applicant's undersigned representative.

Respectfully submitted,

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